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SCOPE OF PROTECTION: COMPARISON OF GERMAN AND ENGLISH COURTS' CASE LAW

SAŠA BAVEC*

I. INTRODUCTION

It is widely believed that the interpretation of the scope of patent protection in the European Union (EU) differs from country to country. Since the national patent laws of EC member states are harmonised with the European Patent Convention (EPC), it could be expected that decisions of the courts based on the same legislation would not differ greatly. However, the question that arises here is what are the reasons for such differences.

Germany and the United Kingdom (U.K.) are considered two extremes in their decisions regarding the scope of patent protection. The aim of this Article is to review the legal framework, practice, and case law on the issue of the interpretation of patent scope in Germany and the U.K. At the same time, the legal principles applied by courts in Germany and the U.K. in different patent cases will be discussed, and the differences in the application of patent law will be examined. If any differences are found, they will be analysed, and their influence on the results of court decisions will be examined.

II. LEGAL BASE FOR DETERMINATION OF SCOPE OF PATENT PROTECTION

Article 69 (1) of the EPC states:

The extent of the protection conferred by a European patent or European patent application shall be determined by the terms of the claims. Nevertheless, the description and drawings shall be used to interpret the claims.¹

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1. European Patent Convention, 1978, art. 69.

To avoid conflicting understandings and interpretations of the above-cited article by national courts, the "Protocol on the Interpretation of Article 69 of the European Patent Convention" (Protocol) was adopted with the following wording:

Article 69 should not be interpreted in the sense that the extent of the protection conferred by a European patent is to be understood as that defined by the strict, literal meaning of the wording used in the claims, the description and drawings being employed only for the purpose of resolving ambiguity found in the claims. Neither should it be interpreted in the sense that the claims serve only as a guideline and that the actual protection conferred may extend to what, from a consideration of the description and drawings by a person skilled in the art, the patentee has contemplated. On the contrary, *it is to be interpreted as defining a position between these extremes which combines a fair protection for the patentee with a reasonable degree of certainty for third parties.*²

Similar provisions have been included in the national patent acts of the EPC member states as well. With adoption of the Protocol, it seemed that the basis for harmonisation of national court treatment of the interpretation of the scope of patent protection was established. It was also believed that ensuring uniformity of criteria would lead to uniformity in decisions of the member states' courts. The decisions of U.K. and German courts in *Epilady VIII*³ in 1990 terminated any illusions of uniformity. The courts of those two countries came to completely different conclusions on whether a patent granted for very simple technology was infringed.⁴

Today, more than ten years after the *Epilady* decision, we still cannot say that legal practice on the issue of the interpretation of the scope of protection is harmonised across the EPC member states.⁵ The

2. The "Protocol on the Interpretation of Article 69 of the Convention" was adopted at the Munich Diplomatic Conference for the Creation of a European System for the Grant of Patents on October 5, 1973 (emphasis added).

3. *Improver Corp. v. Remington Consumer Prods. Ltd.* [1990] F.S.R. 181 (Eng. Patents Ct.); *Epilady VIII* [1993] Gewerblicher Rechtsschutz und Urheberrecht-International Part 242. Actually, the *Epilady* case was litigated in parallel across almost all of Europe. The Austrian Court of Appeal did not find an infringement, while Dutch and Italian courts found an infringement.

4. The invention in question was an electrical device for plucking hairs from the body.

5. At the end of the millennium, the courts of Germany, France, and Switzerland came to different results in *Müller-Hilty* on the simple technology of pipe clamps. Some courts held that there was literal infringement; but for other courts, there was no infringement, not literally or even by equivalence. See Mario Franzosi, *Three European Cases on Equivalence* -

reasons for the different decisions are still hidden and are the subject of several discussions.⁶

III. PATENT INFRINGEMENT PROCEEDINGS

European patents are subject to the national legislation and practice of each EPC member, whose common rules of the EPC relate to the determination of the scope of protection and enforcement. National courts also deal with validity issues of European patents. When the scope of protection is determined and the court tests for infringement, the question of patent validity usually arises. At this point, the first difference between Germany and the U.K. can be identified.

In Germany, infringement cases are dealt with exclusively in civil courts. These infringement courts (District Courts, "Landesgericht," as the first instance, and Courts of Appeal, "Oberlandesgericht," as the second) decide only the question of infringement and are bound by decisions issued by the European Patent Office, German Patent Office, and the Federal Patent Court, "Bundespatentgericht." The infringement courts do not have jurisdiction to deal with validity issues. Patents can be revoked or invalidated only by the Patent Office and the Federal Patent Court. The Federal Supreme Court, "Bundesgerichtshof," as the last and final instance, deals with patent infringement and validity. In the U.K., the situation is different. The same court that decides patent infringement can test the validity as well. Usually, these decisions are made in the same proceeding.

The tests for infringement in both Germany and the U.K. are two-step processes.⁷ In the first step, the court gives meaning to the claims.

Will Europe Adopt Catnic? 32 INT'L REV. INDUS. PROP. COPYRIGHT L. 113, 113 (2001) [hereinafter I.I.C.].

6. See generally Franzosi, *supra* note 5, at 113-24; Are Stenvik, *Protection for Equivalents Under Patent Law - Theories and Practice*, 32 I.I.C. 1-20 (2001); Dieter Brändle, *Can and May Interpretation and Determination of the Extent of Protection of a European Patent in Different Countries Lead to Different Results?*, 30 I.I.C. 875-82 (1999); Klaus Grabinski, *Can and May Determination of the Extent of Protection Conferred by a European Patent in Different Countries Lead to Different Results?*, 30 I.I.C. 855-74 (1999).

7. Laddie, J. stated in *Am. Home Prods. Corp. v. Novartis Pharms. U.K. Ltd.* [2000] R.P.C. 547, 557-58 (Eng. Patents Ct.) (decided by the High Court on Dec. 6, 1999):

It seems to me that the inquiry as to the scope of the invention protected by a patent involved two distinct steps. The first is for the court to understand what the document says. To the extent that the claims and specification use technical words, they may need to be explained by relevant experts. Once this has been done, the *technical meaning* of the specification and claims should be clear. The second stage is to determine what is the scope of the invention protected by patent. In other words, it is a determination of the *effect* of the wording used. This is the function of

The purpose of this step is to determine the scope of the patent, which is defined by the language of the claims. This “fence” around the field of the invention shall be defined by the wording of claims, the description, and the drawings.⁸ The second step is to decide on infringement. Claims, as constructed, create a framework for the determination of infringement. If the attacked embodiment is literally covered by the claims, the court will, as a general rule, find literal or textual infringement. If no literal infringement is found, the court must decide whether there is an infringement under the so-called “theory of equivalence.”

Regarding the first step, “the construction of claims,” the legal principles of German and U.K. courts are almost the same and are very rarely disputed. The situation is different when the doctrine of equivalence comes into question. Legal principles related to the doctrine of equivalence are burdened with significant uncertainty and are, to some extent, in dispute internationally. Despite this uncertainty, generally accepted legal concepts can be identified.⁹

IV. CLAIM INTERPRETATION

The EPC has stated that the function of patent claims is to “define the matter for which protection is sought. They shall be clear and concise and be supported by the description.”¹⁰ The “fence post”¹¹ or “sign post”¹² approaches, as they were applied in the U.K. and

the judge.

[2000] R.P.C. 547, 557-58 (emphasis in original). The two-step test was also applied in, for example, *Ion Analysis* [1988] *Gewerblicher Rechtsschutz und Urheberrecht* [hereinafter *GRUR*] 896 (decided by German Federal Supreme Court).

8. According to article 69 of the EPC and the Protocol, the scope of the protection shall not be defined by the strict, literal meaning of the wording used in the claim. The description and drawings shall be used to interpret the claims as well. Paul Tauchner stated that the scope of patent protection is not restricted to the wording of the patent claims but is defined by their “terms,” which have to be determined by interpretation. See Paul Tauchner, *The Doctrine of Equivalence in Germany*, *IP LITIG. Y.B.* 9, 9 (2000).

9. See generally Stenvik, *supra* note 6, at 1-20.

10. See European Patent Convention, 1978, art. 84. The German Patent Act does not contain a provision corresponding to article 84 of the EPC. Formal requirements for claim drafting are found in section 4 of the *Patentanmeldeverordnung* (Order Concerning German Patent Application). The United Kingdom Patent Act of 1977, section 14(5), contains a provision similar to article 84 of the EPC.

11. Under the old approach of U.K. courts, the function of claims was to define the outer borders of the invention (to define a fence around the field of the invention).

12. Under the old approach of German courts, the claims serve only as pointers or signposts to the invention for which the patent was granted. The claims were used only as a starting point for the determination of patent scope.

Germany, shall no longer be employed for the interpretation of claims. According to Article 69 of the EPC, the claims shall be interpreted in a way that "a person skilled in the art"¹³ would read and understand them and draw specific conclusions from them. During the claim interpretation, a court takes the claim wording under a microscope and defines the meaning of each term in light of the description and the term's meaning for a person skilled in the art.

The above-mentioned principle of the interpretation of claims was used in *Absetzvorrichtung*¹⁴ and *Bierklärmittel*¹⁵ of the German Bundesgerichtshof and in *Catnic Components Ltd. v. Hill & Smith Ltd.*¹⁶ of the U.K. court. The well-established rule that claims should be construed through the eyes of a person skilled in the relevant art, who is assumed to possess the common knowledge available in his or her field at the priority date of the patent, was confirmed by two landmark decisions, *Formstein*¹⁷ and *Catnic*.¹⁸

As it can be understood from German legal practice regarding patentability and determination of the scope of protection, terms in the patent claims must be interpreted so that an expert, addressed and familiar with the specific technical field of the patent, understands them, considering the entire contents of the specification and the objective solution disclosed in the patent.¹⁹ In the case of divergence between the general technical meaning of a term and the specific meaning of that term, as it results from the whole content of the patent, the latter meaning should prevail.²⁰

13. The definition of a person skilled in the art differs from case to case, and it strongly depends on the field of technology to which the invention is related. For an illustration of what can represent a person skilled in the art of biotechnology, see the following decisions of the European Patent Office (EPO) and U.K. courts: President and Fellows of Harvard College, Entscheidung der Technischen Beschwerdekammer 268 (F.R.G.), translated in 6 OFFICIAL J. EUR. PAT. OFF. 268 (1992) (effusion proteins); T500/91, Biogen Inc. v. Medeva plc, Eur. Pat. Off. Rep. 69, (1995) (alpha-interferon II); T412/92, Kirin-Amgen, Eur. Pat. Off. Rep. 629 (1995) (erythropoietin); Kirin-Amgen Inc. v. Transkaryotic Therapies Inc. (unpublished decision of U.K. Patents Court, Chancery Division, dated April 11, 2001). See also GOLDBACH ET AL., PROTECTION OF BIOTECHNICAL MATTER UNDER EUROPEAN AND GERMAN LAW, 55-56 (Grünecker et al. eds., 1996).

14. [1983] GRUR 497.

15. [1984] GRUR 425.

16. [1982] R.P.C. 183, 242 (Eng. H.L.).

17. [1986] GRUR 803.

18. [1982] R.P.C. 183.

19. Brieflocher [2001] GRUR 232; Prospekthalter [1997] GRUR 116; Elektrische Steckverbinder [1995] GRUR 330.

20. Spannschraube [Tension screw], BGH Case No. X ZR 85/96 (F.R.G.), translated in

The practice of U.K. courts in interpreting the scope of protection is best characterised by the words of Lord Diplock in *Catnic*: "A patent specification should be given a purposive construction rather than a purely literal one derived from applying to it the kind of meticulous verbal analysis in which lawyers are too often tempted by their training to indulge."²¹

The patent is to be construed through the eyes of a person (or a team of persons) appropriately skilled in the relevant art, but the construction as such is ultimately a matter for the court. "[T]he court must adopt the mantle of the notional skilled addressee and determine . . . what the notional skilled addressee would understand to be the ambit of the claim."²²

In a case related to erythropoietin, Justice Neuberger stated that the construction of patents in new technological fields, such as biotechnology, often requires the assistance of experts.²³ However, it is important to remember that, particularly in a fast developing field, evidence must be judged bearing in mind the passage of time since the relevant date. When technology has developed significantly since the priority date, the meaning of an expression may be expanded to incorporate a new development, contracted to limit the previous art, or significantly changed.

A. Legal Certainty

To ensure legal certainty for third parties, as required in the last sentence of the Protocol, one should regard patent claims not merely as starting points, but also as decisive bases for the determination of infringement. Embodiments that do not have sufficient bases in the terms of the claims are excluded from the scope of protection of such claims.

In Germany, the patent applicant must ensure that the subject

30 I.I.C. 932 (1999).

21. [1982] R.P.C. 243.

22. *Lubrizol Corp. v. Esso Petroleum Co.* [1998] R.P.C. 727, 738 (Eng. C.A.). See Ian Karet, *Update on Biotech Patent Litigation*, in PROTECTING AND EXPLOITING BIOTECHNOLOGICAL INVENTIONS (IBC Global Conferences Ltd. ed., 2000) (conference documentation). This was confirmed in *Wheatley v. Drillsafe Ltd.* [2000] IP&T 1067, ¶¶ 18-26 (C.A.), where Aldous, L.J. explained: "The object of interpretation is to ascertain the intention of the author, in this case the patentee. This involves examining the words of the claim through the eyes of a person to whom the specification is directed, in the context of the specification as whole." *Kirin-Amgen* [2001] ¶ 57 (citing *Wheatley* [2000] IP&T 1067, ¶ 22).

23. See *Kirin-Amgen* [2001].

matter, which shall be protected, is properly defined in the features stated in the patent claims. Any third person should be able to rely on the fact that the invention protected by the patent is completely defined by the features stated in the claims.²⁴

The extension of the scope of protection to a method[,] which a person skilled in the art is able to find due to his technical expertise and on the basis of the patent description but which has not found expression or support in the claims, is not consistent with the requirement of legal certainty.²⁵

For reasons of legal certainty, in certain circumstances, German courts prohibit extension of the scope of interpretation to equivalents. This limiting effect on the scope of claims may contradict with statements made by the Patent Office or Patent Court. Statements or renouncements of the patentee during proceedings before Patent Office or Patent Court can have a similar effect.²⁶ These exceptions are usually implemented into the patent so they can easily be identified.²⁷

The position of the U.K. regarding legal certainty is similar to the German position. The patentee is responsible for proper and careful drafting of claims, and it is not for the court to rewrite and reformulate the claims in broader language.²⁸ Principle purposive construction is normally used to extend the scope of protection beyond the literal meaning of claims, but a patentee cannot use this method as an excuse merely to use the claims as a guideline or to ignore specific integers.²⁹

24. Batteriekastenschnur [Handle Cord for Battery] [1989] GRUR 903.

25. Tauchner, *supra* note 8, at 10 (citing Schwermetalloxidationskatalysator [Heavy Metal Oxidation Catalyst] [1989] GRUR 205).

26. GOLDBACH ET AL., *supra* note 13, at 347; VCH Verlagsgesellschaft, Weinheim (FRG), VCH Publishers, New York, 347.

27. Befestigungsvorrichtung I [1987] GRUR 280.

28. Laddie, J. stated in *Brugger v. Medic-Aid Ltd.* [1996] R.P.C. 635, 649 (Eng. Patents Ct.):

If a patentee has chosen to define the characterising part of his claim in narrow terms it is not for the court to rewrite in broader language simply because it thinks a wider form of wording would have been easier to formulate. No doubt it could be said that a limitation to an insert which is cylindrical is very narrow. It could be avoided by having inlet flue and insert with square cross-section. But that is how the patentee has chosen to define his monopoly.

Gordon Harris, *Trends in U.K. Patent Litigation: The Age of Reason?*, 5 EUR. INTELL. PROP. REV. 254 (1999).

29. In *Société Technique de Pulverisation Step v. Emson Europe Ltd.* [1993] R.P.C. 513, 522 (Eng. C.A.), Hoffmann, L.J. stated that,

The well known principle that patent claims are given a purposive construction does not mean that an integer can be treated as struck out if it does not appear to make any difference to the inventive concept. It may have some other purpose buried in

“[T]here is no formal doctrine of estoppel in UK, [but] the contents of the prosecution file of a patent may affect the interpretation of claim wording.”³⁰

B. Theory of Equivalence

The theory of equivalence extends protection beyond the literal scope of claims. A question always arises as to the limits of such expansion. Courts should be especially careful not to extend protection to fields already comprised in the state of the art, which must be kept free for everyone to exploit. Protection should not be extended beyond the contribution of the invention to the state of the art, since such unreasonably broad protection can hinder further technical progress.³¹ Embodiments that are unequal and do not apply the advantages of the patented invention, regardless if they are new and inventive, shall be excluded from the scope of protection as well. German and U.K. courts have developed special tests to determine the limits of the extension of protection beyond the literal meaning of claims.

According to German case law, the court would consider that there may be use of the protected invention if the person skilled in the art can find the modified means applied in the contested embodiment by means of his or her expert knowledge in order to equally solve the problem underlying the invention. To find patent infringement by equivalence, it is not sufficient to establish that two types of products, and the equivalent effect they achieve, share the same “fundamental idea.”³²

When infringement under the doctrine of equivalence is determined, it is generally accepted that the mere linguistic or scientifically logical meaning of a claimed expression is not decisive, but rather the understanding of the skilled person in view of the patent specification

the prior art and even if this is not discernible, the patentee may have had some reason of his own for introducing it.

30. Report of British International Association for the Protection of Industrial Property in AIPPI Yearbook 1998/V Reports Q 142, *Breadth of Claims, Support by Disclosure and Scope of Protection of Patents*, 115, 120.

31. According to Zerlegvorrichtung für Baumstämme [segmentation device for tree trunks] [1994] Mitteilungen der deutschen Patentanwälte [hereinafter Mitt.] 181 of the German Supreme Court and to Kastner v. Rizla Ltd. [1995] R.P.C. 585 (Eng. C.A.) of the U.K. court, the range of equivalence might not be extended to cover an embodiment which is based on an inventive step in comparison with the patented teaching. See Joseph Straus, *The Development of Equivalence in Legal Theory and Case Law in Germany and After EPC*, 16-17 (undated).

32. This was stated already in *Formstein*, and it was reaffirmed in *Ioneanalyse* [1988] GRUR 896. See also Straus, *supra* note 31, at 15-16.

controls.³³ In *Formstein*, the German Bundesgerichtshof set up the following two questions as decisive when an equivalent use of an invention is judged:

1. Does the modified means of the allegedly infringing embodiment achieve the same effects as the corresponding means of the claimed invention?
2. Was this modified means of the allegedly infringing embodiment predictable or obvious to a skilled person in consideration of the prior art in combination with his general knowledge, i.e. was it accessible without inventive effort?³⁴

Equivalence is evaluated by comparing the function of the features of the patent claim[,] which contribute to the solution of the technical problem of the patent in suit with the function of the features of the infringement form. Here, the decisive question is whether the skilled person having knowledge of the claimed invention will be able to solve the technical problem underlying the patented invention with modified but equivalent means, ie [sic] whether he will arrive at the desired result with other (modified) means which also lead to the desired result

. . . .

. . . In other words, when the means of solving the problem of the infringement form correspond with the features stated in the patent claims with respect to their technical function and when these means of solving the problem lead to (substantially) the same effect, then the patented invention is used, ie [sic] infringed in an equivalent manner.³⁵

The scope of disclaimers contained in claims is interpreted narrowly.³⁶

In German infringement proceedings, it is an admissible defence³⁷ that the alleged equivalent infringement does not represent a patentable invention since it is known from the prior art, and also since it was obvious in the view of prior art.³⁸ Such a defence is applicable only when infringement within the doctrine of equivalence is to be judged. It cannot be used in a case where literal infringement is found. The Higher Regional Court in Düsseldorf found that pro-urokinase

33. *Spannschraube*, 30 I.I.C. 932 (1999).

34. GOLDBACH ET AL., *supra* note 13, at 347 (citing *Formstein* [1986] GRUR 803); VCH Verlagsgesellschaft, Weinheim (FRG), VCH Publishers, New York, 347.

35. Tauchner, *supra* note 8, at 10.

36. Case no. 4 O 285/98 (Decided in May 2000 by the Regional Court in Düsseldorf).

37. It is also called the "*Formstein* defense."

38. *Formstein* [1986] GRUR 803.

prepared by genetic engineering infringed a patent for pro-urokinase isolated from a biological source.³⁹ The differences between these products were in only molecular mass, due to lack of glycosilation in the recombinant product and specific activity. The court found infringement in an equivalent manner. Explanation for the decision was that these deviations were within the scope of protection, since a person skilled in the art could recognise at the priority date that pro-urokinase obtained by use of recombinant techniques would provide the same effect as that of the patent-in-suit.

The features of an attacked embodiment cannot be considered as functional equivalents to patented features if these alternative features completely refrain from achieving the advantages of the patented invention.⁴⁰

U.K. courts employ purposive construction for the interpretation of patent claims. Applying this test, the courts ask the so-called "*Catnic/Improver* questions" (also referred to at an earlier time as "Protocol questions"), which were set out to determine whether an integer in an alleged infringement corresponds to a particular feature of a patent claim when the correspondence is not immediately apparent from the wording of the claim. The questions that serve for purposive construction of claims were employed for the first time by Lord Diplock in *Catnic*,⁴¹ but they obtained their present form in *Improver*,⁴² where Justice Hoffmann (now Lord Hoffmann) asked the following questions:

1. Does the variant have a material effect upon the way the invention works? If yes, the variant is outside the claim. If no—
2. Would this (i.e. that the variant had no material effect) have been obvious at the date of publication of the patent to a reader skilled in the art[?] If no, the variant is outside the claim. If yes—
3. Would the reader skilled in the art nevertheless have understood from the language of the claim that the patentee intended that strict compliance with the primary meaning was an essential requirement of the invention[?] If yes, the variant is outside the claim.⁴³

39. [1992] 2U 52/89 (division of the Oberlandesgericht [German Upper Regional Court]).

40. *Spannschraube*, 30 I.I.C. 932 (1999).

41. [1982] R.P.C. 183.

42. [1990] F.S.R. 181.

43. *Improver* [1990] F.S.R. 181, 189. "[A] negative answer to the last question would lead to the conclusion that the patentee was intending the word or phrase to have not a literal

The approach was reaffirmed later in several other decisions.⁴⁴

In the U.K., the so-called "Gillette defence" can be used to avoid extension of protection in the field of prior art. This defence can be used where literal infringement is found. The courts have confirmed this practice in recent decisions, such as *Société Technique de Pulverisation Step*⁴⁵ and *Johnson Electric Industrial Manufactory Ltd. v. Mabuchi Motor Kabushiki Kaisha*.⁴⁶ In *Beloit*, it was stated that Article 69 of the EPC "does not legitimately allow courts to construe claims using the prior art either to widen them or narrow them."⁴⁷

In Germany and the U.K., infringement under the doctrine of equivalence can be found in cases even where a patent was granted for the attacked embodiment. If the attacked embodiment in its specific form can be reduced to a more abstract teaching, then the scope of protection of the patent-in-suit will have to be determined not with respect to the specific form of the attacked embodiment, but only with respect to this more abstract teaching. Consequently, if a person skilled in the art of looking at the patent-in-suit could find this abstract teaching on which the functionally equivalent embodiment is based, the attacked embodiment will fall under the patent-in-suit.⁴⁸

C. Claims with Numerical Limits

The question that arises regarding claims with numerical limits is whether a five percent deviation from the set limits is enough to avoid infringement or whether this difference should be fifty percent. From the patent cases, one can see that no general rule on this issue exists and that the extent of the protection of claims with numerical limits should be determined on a case-by-case basis.

In *Bierklärmittel*, the German court stated that the effective protection of a patent whose claims contain numerical and measured values cannot be extended to areas that essentially deviate from the

but a figurative meaning . . . denoting a class of things which included the variant and the literal meaning, the latter being perhaps the most perfect, best-known or striking example of the class." *Id.*

44. *Kastner* [1995] R.P.C. 585; *Chiron Corp. v. Murex Diagnostics Ltd.* [1996] R.P.C. 535 (Eng. C.A.); *Beloit Techs. Inc. v. Valmet Paper Mach. Inc.* [1995] R.P.C. 705, [1997] R.P.C. 489 (Eng. C.A.); *Wheatley* [2000] IP&T 1067; *Am. Home Prods.* [2000] R.P.C. 547.

45. [1993] R.P.C. 513, 518.

46. [1996] F.S.R. 93 (Eng. Patents Ct.).

47. [1995] R.P.C. 705, 720.

48. Reinhardt Schuster & Martin Köhler, *Germany: Latest Trends in Patent Infringement Cases*, STRATEGY Y.B. 11 (2000).

claim if the new inventive teaching of the patent resides in these numbers and measurements. However, what should be understood as “essentially deviating” has not been generally defined yet. If the person skilled in the art would recognise, on the basis of the details of the patent specification, that given content ranges are not boundary values, which are critical in the sense that particular properties of the patented invention will no longer be present outside the given ranges, an infringement can still be found if the attacked embodiment is outside the literal boundaries set up in the patent claim. From the recent case *No. 4 O 58/98*, it can be learned that if a numerical value represents a minimum or maximum, the same may, as the court ruled in this case, constitute the border line, and no value extending beyond this value may be considered as encompassed within the claim.

In *Auchincloss v. Agricultural & Veterinary Supplies Ltd.*,⁴⁹ a U.K. court concluded that where a claim specified a range or upper and lower limits expressed in numerical terms, a departure from that range was not a variant in the *Catnic/Improver* sense of the word. The latest case on construction of numerical limits in the patent claims, *Goldsmith AG v. Euro-O-Compound*,⁵⁰ shows that one needs to construe patent claims by taking each patent as a whole, and then by applying purposive construction to that particular document, so as to understand the intention of the patentee.

D. Product and Product-by-Process Claims

According to the decision “Trioxan”, [sic] it is irrelevant whether the product is described in the claims by means of its structural formula or by means of its way of preparation (so-called “product-by-process”). An identical product which is prepared by a different process is . . . [still] within the scope of protection of a product-by-process claim. An explanatory indication of a purpose or effect in a product claim . . . generally does not have a [limiting] effect.⁵¹

From the decision *Oberflächenactives Material*,⁵² it can be extracted that in the case of product-by-process claims, the use of a different process does not necessarily lead away from the protective scope. If the process

49. See [1997] R.P.C. 649 (Eng. Patents Ct.).

50. Decided by D. Young QC on January 25, 2000 (unreported).

51. GOLDBACH ET AL., *supra* note 13, at 348 (citing Trioxan [1972] GRUR 80); VCH Verlagsgesellschaft, Weinheim (FRG), VCH Publishers, New York, 347.

52. [Surface active agent] Case no. 4 O 265/95 (decided on August 6, 1996 by the Regional Court in Düsseldorf).

features in the product claim impart a specific characteristic to a claimed product, this characteristic has to be read into claims.

Product-by-process claims are also admissible under U.K. practice in cases where a product is not novel. The position of U.K. courts is that if the product cannot be characterised by means other than by the process used for its preparation, the claim shall be regarded as a classic product claim. If that process is novel, but the product as such is not novel, the claim should be given the meaning and effect of a process claim. In such a case, the protection conferred by a product-by-process claim should extend to the products obtained by a novel process or an equivalent.⁵³

E. Process Claims

The scope of protection of process patents extends only to the product directly obtained by such process. "The scope of protection extends not only to equivalent modifications of the process steps, but also to the starting materials."⁵⁴ The situation is the same in the U.K. as well.

F. Second Medical Use

In the case of patent claims directed to the use of a substance for treatment of specific diseases, the German Bundesgerichtshof considers the formulation⁵⁵ and manufacturing of the medicament, its dosage, its by-pack instruction, and its ready-to-use packing to be expressly covered by the use claim.⁵⁶ The difference between U.K. and German courts on this issue lies in the definition of what makes an invention susceptible to industrial application. In Germany, a provision on a product sheet enclosed with a medicament to be put on the market is sufficient.

In Germany, practice follows the rule that for known products, of which the medical effects are found for the first time, purpose-limited product claims are allowed. The claims can be written in the following form: "Substance X for use as a medicinal product." Where a specific

53. See also *Kirin-Amgen* [2001] ¶¶ 75-80.

54. GOLDBACH ET AL., *supra* note 13, at 349. See also *Metronidazol* [1975] GRUR 425.

55. The assumption that the formulation is already covered by the use of the invention is important in respect to the fact that it allows the invention to be considered susceptible to industrial application. In *Hydropiridine*, the court accepted use claims that were not written in so-called "Swiss-form." See GOLDBACH ET AL., *supra* note 13, at 349.

56. This opinion of Bundesgerichtshof was repeated in several cases like, *Sitosterylglykoside* [1982] GRUR 548; *Hydropiridine* [1983] GRUR 729; *Bierklärmittel* and *Antivirussmittel* [1987] GRUR 794. GOLDBACH ET AL., *supra* note 13, at 348-50.

medical use has been incorporated in the claims as an essential element, the scope of protection of such claims in Germany is limited to the recited use.⁵⁷

The present U.K. position on this issue is that methods of medical treatment as such are unpatentable.⁵⁸ In *Bristol-Myers Squibb Co. v. Baker Norton Pharmaceuticals Inc.*,⁵⁹ strong comments indicated that the treatment exception contained in Article 52(4) of the EPC should be narrowly construed to prevent patent law from interfering directly with what a doctor actually does to a patient.

The effect of this difference is evident from the decisions of German and U.K. courts in *Hydropiridine*⁶⁰ and *Bayer AG (Meyer's) Application*.⁶¹ The first has allowed and the second has rejected claims related to the use of hydropiridine. The U.K. court strictly follows the decision of the Enlarged Board of Appeal in *Eisai Co.*⁶² and accepts second medical use claims only in the form of Swiss claims: *Use of substance A for the manufacture of a medicinal product for the treatment of disease B*.

According to German case law, the step of manufacturing can be left out of the second medical use claim, and a German court has allowed the following claim: *Use of substance A for the treatment of disease B*.

V. ARE THERE DIFFERENCES IN THE LEGAL PRACTICE AND CASE LAW BETWEEN GERMAN AND U.K. COURTS?

From the facts above, it can be concluded that Article 69 of the EPC and the Protocol have affected the legal practice of German and U.K. courts. These two provisions were incorporated in national patent acts causing national courts to abandon the legal principles related to the interpretation of the scope of protection and determination of infringement that had lain outside the settled framework. What remains from the old principles is the legal tradition that is hidden within the

57. *Antivirumittel* [1987] GRUR 794. GOLDBACH ET AL., *supra* note 13, at 348-50.

58. Anna Feros, *Patentability of Methods of Medical Treatment*, 2 EUR. INTEL. PROP. REV. 79, 84 (2001). The situation may change in the near future, since an amendment to the EPC to give a clear basis for the patenting of second and subsequent medical uses for pharmaceutical substances was agreed upon by the Diplomatic Conference on the EPC in November 2000.

59. [1999] R.P.C. 253, 274 (Eng. Patents Ct.).

60. [1983] GRUR 729.

61. [1984] R.P.C. 11 (Eng. Patents Ct.).

62. Entscheidungen Der Grossen Beschwerdekammer 59, 64 (F.R.G.), *translated in* 3 OFFICIAL J. EUR. PAT. OFF. 59, 64 (1985) (second medical indication).

legal framework.

Despite the harmonisation of legal framework, the differences between patent infringement proceedings still exist. When deciding on infringement, German civil courts are bound by the claims as granted, while U.K. courts allow their English colleagues to deal at the same time and in the same proceeding with the issue of validity of patent and infringement.

The actual words used by courts in Germany and the U.K. to describe the principle of "construction of claims" are different, but the words' meanings are the same. The message that can be deduced is that claim construction is ultimately a matter to be dealt with by the court. The court should interpret the claims and terms in a way that a person skilled in the relevant art understands them in consideration of the entire contents of the specification and the objective solution disclosed in the patent. The general principles on how to define the characteristics of the person skilled in the art are shared by German and U.K. courts.

Legal certainty is of great importance for both German and U.K. courts. The patentee is the person responsible for proper and careful drafting of the claims, and it is not the duty of the court to rewrite and reformulate claims in broader language. Third parties shall be able to rely on the fact that the invention is completely defined by the features stated in the claims. The extension of the scope of protection to a method, which has not found expression or support in the claims, is not consistent with the requirement of legal certainty. In the U.K., the principle of legal certainty is incorporated in the Protocol test as its third question.

The principle of determining infringement under the doctrine of equivalence can be considered the same. The German courts cite that their decisions are in correspondence with the principles developed in English case law within the framework of the *Catnic* questions.⁶³

German and U.K. courts apply the same principles when determining the scope of different types of patent claims. Difference arises only in the case of second medical use claims, but even this difference will be omitted by the proposed amendments to the EPC.⁶⁴

63. *Spannschraube*, 30 I.I.C. 932 (1999). See Franzosi, *supra* note 5, at 113-24.

64. The idea was to include a new article 54(5) in the EPC, which would unambiguously permit purpose-related product protection for each new medical use of a substance or composition already known as a pharmaceutical. It was supported by all delegations at the Diplomatic Conference for the Revision of the EPC held in Munich in November 2000. For

VI. CONCLUSION

It is widely believed that the differences between legal practice and principles applied by German and U.K. courts when determining the scope of patent protection are significant, clearly evident, and can be easily identified.

However, this Article's analysis shows that the reality is quite the opposite. The only significant difference between Germany and the U.K. that can be identified is the inability of German courts to decide on the validity of patents in infringement proceedings.

U.K. courts usually test the validity of the patent after the testing of infringement. That system offers courts an opportunity to invalidate the claim that is infringed, as shown by the courts' patent decisions in *Biogen* and *Pfizer Ltd.*⁶⁵ Instead of invalidating the claim, the court can simply interpret the claim in a narrower or literal sense, as was done in *American Home Products Corp.*⁶⁶ The language of the claim binds German courts, but the effect of the patent beyond the literal meaning of the claim can be limited by the *Formstein* defence.⁶⁷ Under the

more, see Ralph Nack & Bruno Phélip, *Diplomatic Conference for the Revision of the European Patent Convention: Munich, 20-29 November 2000*, 32 I.I.C., 200, 204 (2001).

65. Hoffmann, L.J. stated in *Biogen*:

Thus if the patentee has hit upon a new product which has a beneficial effect but cannot demonstrate that there is a common principle by which that effect will be shared by other products of the same class, he will be entitled to a patent for that product but not for the class, even though some may subsequently turn out to have the same beneficial effect On the other hand, if he has disclosed a beneficial property which is common to the class, he will be entitled to a patent for all products of that class (assuming them to be new) even though he has not himself made more than one or two of them [T]he claims must be supported by the description, in other words, it is the definition of the invention in the claims that needs support [T]his requirement reflects the general legal principle that the extent of the patent monopoly, as defined by the claims, should correspond to the technical contribution to the art in order for it to be supported or justified.

[1997] R.P.C. 1, 49.

66. [2000] IP&T 1308 (Eng. Patents Ct.). "If Claim 1 had the broader scope for which the patentees had argued, then Aldous L.J. concluded that the specification would be insufficient." Paul Cole, *Pioneering Pays—Or Does It?*, 11 EUR. INTEL. PROP. REV. 534, 536 (2000). The specification did not teach how to perform the invention with derivatives of rapamycin, so because although it told the skilled man where to start, it left him to ascertain by research which derivatives work. Claim 1 as such does not reflect a class of molecules with unifying characteristic but was a claim to a number of compounds with the number and identity being left to the skilled person to found out. Besides that, if the patentee had wanted to cover derivatives in its claim it could easily have done so. The patentee has chosen limiting wording in the claim and, as a result, the patent should be so limited. *Id.* at 536-37. See *Kirin-Amgen* [2001] ¶¶ 97-101 (for discussion of *Am. Home Prods.* [2000] IP&T 1308).

67. *Formstein* [1986] GRUR 803.

Formstein defence, the alleged equivalent infringement does not represent a patentable invention if it is known from the prior art and is obvious in view of the prior art. Another possible argument is that the features of the attacked embodiment cannot be considered as functionally equivalent to the patented features when those alternative features completely refrain from achieving the advantages of the patented invention.⁶⁸ The repeated statements of U.K. courts that their decisions on validity are in line with the decisions of the Technical Board of Appeal at the EPO leads the author to the conclusion that this difference of procedural nature is the main reason for the divergences (especially in cases where the patents granted by EPO are in question) between the decisions of German and U.K. courts.

Catnic was criticised as one of the main reasons for divergences by some authors. However, even in *Epilady*, U.K. and German courts gave the same answers on the first two *Catnic* questions; if the German court had applied the same principles on legal certainty as it did in *Batteriekastenschnur*, *Schwermetalloxidationskatalysator*, and very recently *Spannschraube*, the infringement probably would not have been found. The author's opinion is that *Catnic* is like a sensitive measure instrument that shall be operated very carefully, but whose instruction manual is not written to the extent that "the results of measurements" whenever the instrument is applied in the same circumstances can be similar or at least comparable.

Besides legal certainty, which cannot be defined in its absolute sense, a person skilled in the art and general knowledge are other variables through which even a slight variation in their definition can result in different decisions of the courts. A fourth variable that is rarely mentioned is judges themselves. From the existing cases, it is evident that the differences exist not only between national courts but also between different instances in the same country. Differences can be found even between judges deciding the same case on the same instance, applying the same law, and using the same principles. These differences lead to the conclusion that judges are one of the deciding factors that can have a major influence on the side to which the balance between legal certainty and fair protection will tilt.

It can be concluded that patent law is a very sensitive instrument that can give correct results manifested by fair protection for the patentee and legal certainty for third parties only in a neutral and somehow isolated environment. The influence of even a small

68. *Spannschraube*, 30 I.I.C. 932 (1999).

divergence between the environment where the patent law is applied, and the ideal mentioned before the results are obtained, tilts the balance to one of the extremes. These divergences can be represented by national legal traditions that still hold influence on the decisions of national courts; by differences of legal systems in the terms of proceedings legislation; by imaginative terms that are applied for determination of infringement; by persons skilled in the art; and, last but not least, by judges as such.

The question that arises here is: what can be done to eliminate the above-mentioned differences in the courts' decisions? Is it possible to develop a tool that could buffer the differences between different courts in their interpretation of the scope of protection and to reduce the level of uncertainty?

One way toward reduction of uncertainty in Europe could be by establishing a unique European Court of Justice⁶⁹ that would hear all patent infringement cases (and probably cases on validity as well). This approach would eliminate the differences resulting from legal heredity that each nation brings within the common EU home.

From the facts mentioned in this Article, it can be concluded that the patentee and third party can never be sure what will be the effect of the patent in question. Unfortunately, the reality is that nobody knows the real scope of protection granted by a patent until the last court of instance has decided on it. As in real life, it is the case in the patent law that the devil lays in the details, which can push the balance to one extreme or the other.

69. The attempt in December 2001 to come closer to the Community Patent Court was unsuccessful.